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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,394	02/10/2004	Keith Robinson	108298554US2	8893
25096	7590	12/29/2004	EXAMINER	
PERKINS COIE LLP			ROBERT, RUSSELL MARC	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			2829	
SEATTLE, WA 98111-1247			PAPER NUMBER	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,394

Applicant(s)

ROBINSON, KEITH

Examiner

Russell M Kobert

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0204.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's election with traverse of Species (c), claims 32-36, in the reply filed on October 19, 2004 is acknowledged. The traversal is on the ground(s) that the search and examination can be made without serious burden and the examiner has merely made a statement of conclusion that the grouped claims represent separate species without providing any rational for the restriction. This is not found persuasive because Applicants have not shown that the species are not patentably distinct. Admission on the record by Applicants that the species are not patentably distinct will result in rejoinder. Applicants appear to be arguing that same subclass of classification means same invention. If such were carried to its logical conclusion there could only be one patent per subclass and Applicants could be denied a patent on the basis that there is already at least one patent in Class 324, Subclass 755. With regard to the "without serious burden" argument, it is noted that each distinct invention beyond one is a burden in that it draws the attention of the Examiner to its own requirements. Examination requires focus to follow search leads and patterns of logic in formulating applications of the prior art to that which is claimed. When the Examiner has to pursue several search patterns of logic simultaneously or serially, added burden is presented. In order to examine several inventions and/or species simultaneously or serially, added effort beyond that necessary for one invention or species must be expended. Where the effort is serial and the jobs are different the added burden is obvious. Digging two equal holes of the same size requires twice the effort of digging one hole. Such is an obvious conclusion. It can be argued that some inventions or species can be examined simultaneously but such is true only if they are not patentably distinct, that is, if that

which applies to any one applies to all others. Where inventions or species are patentably distinct each requires separate consideration. As a for instance, consider a properly restrictable apparatus and method of use of that apparatus where one has details without correspondence in the other. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other constitutes a burden. If the apparatus and method of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. As a second for instance, consider a properly restrictable combination and subcombination where all the details of the subcombination are not necessary for the combination. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other is a burden. If the combination and subcombination of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. Where species are patentably distinct each requires separate consideration. It is noted that Applicants' claimed species are distinct from each other for at least the following reason: The method steps presented in each of claims 17, 24 and 32 are conducted in distinct sequences from each other and as such are mutually exclusive of one another. Even though the methods presented may generate the same product, the process steps are unique by themselves and as such are drawn to different species.

Applicant is further reminded that any claim that is not supported by the disclosure shall result in the disclosure being deemed inadequate. The examiner has

complied with the requirements of MPEP 809.02(a). Specifically, MPEP 809.02(a) which states:

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict (the latter being encouraged). See MPEP § 812.01 for telephone practice in restriction requirements. Action as follows should be taken:

(A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. **If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted.**

(C) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete reply and his or her rights under 37 CFR 1.141.

For generic claims, a search should not be made and art should not be cited. A 1-month (not less than 30 days) shortened statutory period will be set for reply when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program. To be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

Admission on the record that the species are not patentably distinct will result in rejoinder.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 17-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 19, 2004.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (5764071) in view of either Patel (4055806) or Lin (5523695).

Chan et al shows (see Figure 4):

A method of making a testing device, comprising:

coupling a load board (112) to a base member (412);

removably coupling multiple electrically conductive first contacts (110 and 410) to the base member, the first contacts having first portions (110a and 410a) that are thereby operatively coupled to the load board and second portions (110b and 410b) that are operatively couplable to multiple second contacts (part of DENDRITE INTERPOSER 412 numbered 108 and shown in Figures 3 and 3A as either DENDRITE PLATING 504 or SIGNAL PAD 506);

operatively coupling the second contacts to the second portions of the first contacts (shown as combination of 412, 410b and 110b in Figure 4); and

configuring at least one pin receptacle (upper and lower contacts of PLANAR 102) to be operatively couplable to at least one of the second contacts and to receive pins of an electrical device (ELECTRONIC MODULE 106); as described in claim 32.

Although Chan et al does not show an electrical socket device, either Patel (4055806) or Lin (5523695) show electrical socket devices (see 11 in Figure 1 according to Patel or 30 in Figure 2 according to Lin) implemented as described in claim 32.

As to claim 33, removably coupling the first contacts to the base member via at least one clamp is anticipated by Chan et al (col 2, ln 55-67).

As to claims 34 and 35 Chan et al shows (see Figure 4, connection between PLANAR, DENDRITE INTERPOSER and INTERFACE CABLES) frictional engagement between the second contacts with the second portions of the first contacts and further shows coupling between at least one pin receptacle with the second portions of the first contacts.

As to claim 36, at least Lin shows coupling pins (34) of an electrical socket device (30) to pin receptacles (18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the teaching of either Patel or Lin with that of Chan et al to make the claimed invention because each comprise interconnection structures for electrically connecting an electrical device under test to a load board. Moreover one having ordinary skill in the art would have been motivated to combine the teaching of Patel or Lin with that of Chan et al since the use of a socket to hold an


electronic device, such as the ELECTRONIC MODULE 106 of Chan et al, provides additional flexibility by making Chan et al a multipurpose use testing apparatus that further permits a variety of integrated circuits to be interchanged quickly and easily.

5. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963. The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034. For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
December 20, 2004



DAVID ZARNEKE
PRIMARY EXAMINER
12/22/04